

REMARKS/DISCUSSION:

This Response F is being filed within the shortened period for response that ends on September 23, 2011 along with a Request for Continuing Examination. It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents or the electronic filing accompanying this Response F. However, if additional extensions of time are necessary to prevent abandonment of the above-referenced application, then such extensions of time are hereby petitioned under 37 C.F.R. 1.136(a), and any fees required there for (including fees for filing and net addition of claims) are hereby authorized to be charged to the Deposit Account No. noted below.

By this Response F, claims 1-3, 5-8, 10-14 and 16-21 are pending in this application. The claims remain as previously presented in Response E.

Amendment and/or cancellation of claims are not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, any amendments or arguments are made without conceding the correctness of any of the rejections of the pending Office Action, and Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

A. Rejection under 35 U.S.C. § 103(a)

Claims 1-8, 10-14 and 16-21 stand rejected as being unpatentable over U.S. Patent No. 5,275,607 to Lo in view of Schwemberger, U.S. Patent No. 6,589,200. The Examiner states that Schwemberger discloses the invention as substantially claimed but does not directly disclose the blade being asymmetric and having an end position in an overlapping C9L30-36 with at least a portion of the asymmetric portion of the blade. Lo, in the analogous art, teaches a movable asymmetric blade member 30 with an end

positioned in an overlapping C9L30-36 with at least a portion of the asymmetric portion of the blade. Pg. 2-3 of the OA.

The Examiner further states the lumen of Lo is designed to provide suction or irrigation to a surgical site, see claim 15, C& L33-43. Pg. 3 of the OA.

Finally, the Examiner states the blade of Schwemberger is designed to vibrate in a longitudinal motion coupled with either a transverse or torsional motion and thus the lumen of Lo when combined would be fixed or moveable to a position adjacent to the transverse or torsional node to facilitate suction C5 L40-55. Pg. 3 of the OA.

On the outset, Applicants note that the Examiner has failed to identify the exact physical structure of Lo that makes up the lumen referenced in the OA. Applicants will assume that the lumen is element 38 of Lo, which has been relied upon by the Examiner in previous office actions.

To establish a *prima facie* case for obviousness, the Office must properly ascertain the differences between the prior art and the claimed invention. MPEP § 2141; *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In ascertaining those differences, the Office must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." *In re Wada and Murphy*, Appeal 2007-3733, slip op. at p. 7 (BPAI, January 14, 2008) (quoting *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)) (emphasis in original). The Office must then support a conclusion of obviousness by providing specific reasoning explaining "why every limitation in [the rejected claim] would have been obvious to a person of ordinary skill in the art." *Id.* at pp. 7-8 (emphasis added).

Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because of non-obvious patentable differences between the cited references and the rejected claims. More particularly, Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness.

1. Previous Arguments

In addition to the arguments set out below, Applicants maintain the arguments set out in previous Responses.

2. *Lo Does not Teach a Lumen in an Overlapping Relationship with the Blade*

Each of the independent claims, 1, 16 and 21 recite “a lumen having an end positioned in an overlapping relationship with at least a portion of the asymmetric portion of the blade”. Applicants admit that lumen 38 is positioned in an overlapping relationship with element 30 of Lo. Further, lumen 38 is fixedly attached to element 30. See col. 9, lines 30-45. Lo, however, makes absolutely no disclosure of a lumen in an overlapping relationship with the blade portion of Lo, elements 28b and 30b (See Fig. 1)

In short, it clearly appears that the Examiner’s rejections are mere assertions without the slightest regard to the meaning of the claim limitations of “blade” and/or “waveguide”. This is clear error. The failure to construe the applicant’s claims in light of his specification is, without question, erroneous. As stated by the Federal Circuit Court of Appeals:

The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose. *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001). *See also Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) (“[A claim] term can be defined only in a way that comports with the instrument as a whole.”).

Ignoring this settled law, the Examiner’s rejection ignores the proper meaning of terms of the claims as reflected by the specification and the context—and fallaciously asserts that Lo discloses the claim language as they should defined. See Figs. 1-3 and ¶¶ [0037]-[0039] of corresponding U.S. Pub. No. 2005/0049546. Accordingly, the rejection is erroneous—and should be reversed.

Accordingly, in view of the foregoing amendments and remarks, Applicant respectfully submits that Lo and Schwemberger, whether taken alone or in combination, fail to disclose every element recited in independent claims 1, 16 and 21. At least on the basis the dependency from claims 1 and 16, Applicant respectfully submits that claims 2, 3, 5-8, 10-14 and 17-20 also are non-obvious and patentable over Lo in view of Schwemberger, whether taken alone or in combination. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to the claims.

Applicants further note that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-

obviousness. For example, and not by limitation, claims 6-8 recite placement of the lumen adjacent a node. Lo neither discloses nor suggests a node or placement of the lumen adjacent a node. The examiner incorrectly cites Lo has disclosing “the lumen is fixed or moveable to a position adjacent to the transverse or torsional node to facilitate suction C5 L40-55.”

A reading of the cited disclosure provides no hint that a lumen is fixed or moveable adjacent a transverse or torsional node. Further, Lo neither discloses nor suggests any reference to a placement of anything, let alone a lumen, adjacent to a node. This is understandable since Lo does not teach, and teaches away from ultrasonic energy which transmits by way of a standing wave and defines nodes and anti-nodes. See, for example, ¶[0030] of the instant application.

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Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. § 103(a) have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END0797USNP/VEK.

Respectfully submitted,

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